

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB

SEPT 29, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Rykoff-Sexton, Inc.

Serial No. 75/045,478

Stephen Grubb, Esq. for applicant.

Angela Bishop Wilson, Trademark Examining Attorney, Law
Office 101 (R. Ellsworth Williams, Managing Attorney).

Before Seeherman, Walters and Wendel, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Rykoff-Sexton, Inc. has filed a trademark application to register the mark GIOVANNI for "cheese; meats, namely, beef patties, beef wafer steaks, ham, meatballs, pepperoni, salami, sausage, sliced steak, and steak chips; processed peppers, namely, green pepper strips, roasted peppers and pepper strips in brine; shortening and processed tomatoes, namely, canned whole tomatoes and crushed tomatoes in heavy

puree," in International Class 29, and "coffee, namely, espresso; doughball; mayonnaise; pasta, namely, elbows, fettuccine, lasagna, linguini, noodles, spaghetti and wagon wheels; pizza sauce; spices, namely, basil leaves, bay leaf, black pepper, processed garlic, monosodium glutamate (MSG), oregano leaf, parsley flakes and red cayenne pepper; vinegar" in International Class 30.¹

The Trademark Examining Attorney has finally refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the following previously registered marks, owned by three different entities, that, when used on or in connection with applicant's goods, it is likely to cause confusion or mistake or to deceive:

- GIOVANI'S for "flavoring syrups, namely almond gourmet syrup, chocolate syrup, Irish Cream syrup, Jamaican rum gourmet syrup and hazelnut gourmet [syrup] for sale in the restaurant supply industry"²;
- GIOVANNI'S for "bakery products - namely, bread"³;

¹ Serial No. 75/045,478, in International Classes 29 and 30, filed January 18, 1996, based on use in commerce, alleging dates of first use and first use in commerce, in both classes, as of 1981.

² Registration No. 1,940,288, issued December 5, 1995, on the Supplemental Register, to Inventory Auditors, Incorporated, in International Class 30.

³ Registration No. 1,194,807, issued May 4, 1982, to Wakefern Food Corp., in International Class 30. The registration includes the statement "the term 'GIOVANNI'S is the Italian equivalent of "John's." [Sections 8 and 15 affidavits accepted and acknowledged.]

[The two registrations that follow are owned by the same entity.]

- GIOVANNI'S for "meat," in International Class 29, and "restaurant services," in International Class 42⁴; and



for "restaurant services."⁵

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register with regard to Registration Nos. 1,194,807, 1,452,339 and 1,160,409; and we reverse the refusal to register with regard to Registration No. 1,940,288.

In the analysis of likelihood of confusion in this case, two key considerations are the similarities between the marks and the similarities between the goods and

⁴ Registration No. 1,452,339, issued August 11, 1987, to Giovanni's Pizza, Inc. [Sections 8 and 15 affidavits accepted and acknowledged.]

⁵ Registration No. 1,160,409, issued July 7, 1981, to Giovanni's Pizza, Inc., in International Class 42. [Sections 8 and 15 affidavits accepted and acknowledged.]

services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Regarding the marks, the Examining Attorney contends that applicant's mark is substantially identical to the marks in each of the cited registrations. Applicant does not contest the Examining Attorney's position or discuss the marks in its brief. It is our view that applicant's mark is substantially similar in sound, appearance, connotation and overall commercial impression to the mark in each of the cited registrations. The mark in each of the cited registrations consists of, or includes, the phonetic equivalent of applicant's mark, GIOVANNI. The fact that one of the registered marks is spelled with a single "N" and that each of the registered marks appears in the possessive with an "'S" does not distinguish these marks from applicant's mark. Further, the design element in Registration No. 1,160,409 does not detract from the dominance of the word GIOVANNI'S in that mark. The type style in which the word is shown, while relatively minor, serves to accentuate the word; and the picture, which appears to be of a chef carrying a pizza and roller skating over the word, also serves to focus attention on the word portion of the mark.

Thus, the question of likelihood of confusion turns principally on the relationship between the goods and services herein. As we have said many times before, there is no *per se* rule regarding food items. The very fact that the Examining Attorney has cited four registrations, owned by three different entities, for a mark which is, essentially, GIOVANNI for a variety of food items indicates that the mark may be relatively weak and that careful consideration must be given to the relationship between applicant's goods and those in the cited registrations to determine if confusion is likely in each case. We address this issue separately with respect to each of the cited registrations.

Registration No. 1,940,288

The Examining Attorney contends that applicant's recited "coffee" is related to registrant's flavoring syrups because "coffee and favoring syrups are complementary good items, with flavorings syrups often used in coffee ... [and] these goods are often sold together, in the same trade channels and under the same mark." In support of her position, the Examining Attorney has submitted several third-party registrations reciting both coffee and flavoring syrup in the identifications of goods;

and two mail order catalogs as evidence "that these goods are marketed as complementary goods."

Applicant argues that no likelihood of confusion exists because, "as used in restaurants and the like, no trademarks are attached here, to the coffee or to the flavoring syrup."⁶

While flavoring syrups may be used in coffee, we are mindful of the fact that the cited registration limits its channels of trade to the "restaurant supply industry." Thus, the syrups are not general consumer items, but would be sold to purchasers of restaurant supplies. Presumably, such purchasers are relatively sophisticated about the purchasing decisions being made in this regard and such decisions are made with a degree of care. Because of this, and because of the differences in the goods, we find that confusion is not likely with respect to Registration No.1,940,288.

Registration No. 1,194,807

The Examining Attorney contends that applicant's recited doughballs and meat products are related to registrant's bread because doughballs can be used to make bread, and because meats and breads are often advertised

⁶ We will presume that applicant's statement that "purchasers ... would associate these widely divergent products with the same source of origin" involves a typographical error and we will disregard it.

together and sold together in delis, specialty stores and grocery stores; that purchasers seeing the bread and meats in close proximity to each other are likely to believe they emanate from the same source; and that meats and bread are complementary products used to make sandwiches. In support of her position, the Examining Attorney has submitted excerpts from cookbooks showing entries for meat-filled sandwiches and several unidentified advertisements, presumably from grocery stores, showing, on the same page, advertisements for deli meats and for bread or rolls.

Applicant argues that there is no likelihood of confusion because "it flies in the face of logic and common sense" to speculate that applicant's doughballs may be used to make bakers' items other than pizza crust; and that "the consumer who buys sandwiches would [not] have any knowledge of the source of meat or bread, and the skilled purchasing agents who might handle products clearly can distinguish such products as to source."

We find the Examining Attorney's argument based on a relationship between applicant's recited "doughballs" and registrant's goods to be unpersuasive. There is no evidence in this record either that doughballs are made into bread, or that the sources for doughballs, an unfinished product, would be the same or related to the

sources for bread, a finished product that is ready for consumption.

However, the Examining Attorney has provided some evidence to indicate that meats and breads are advertised together and may be sold in the same stores and, further, that they are complementary products as both products may be purchased together and used together to make sandwiches. Thus, it is not unreasonable to conclude that consumers are likely to believe that applicant's meats come from the same or related source as registrant's bread. *See, In re Colonial Stores, Inc.*, 216 USPQ 793 (TTAB 1982) [likelihood of confusion found between COUNTRY PRIDE for bread and COUNTRY PRIDE for prepared meat products, despite weakness of marks, in view of identical marks and complementary goods which could be sold in same stores]. *But see, Mr. Hero Sandwich Systems, Inc. v. Roman Meal Company*, 228 USPQ 364 (Fed. Cir. 1986) [Court found no likelihood of confusion between ROMANBURGER for sandwiches sold for consumption on or off premises and ROMAN, ROMAN MEAL, and several related marks, for goods including bread. However, court focused on dissimilarities between marks, dissimilar trade channels and lack of actual confusion over a period of years.] We find this case more analogous to the *Colonial Stores* case as our case also involves essentially

identical marks for breads, on the one hand, and meats on the other. Further, if we had any doubt concerning our conclusion that confusion is likely, we would be obligated to resolve such doubt in favor of the registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed Cir. 1988). Thus, we find a likelihood of confusion with respect to this registration.

Registration Nos. 1,452,339 and 1,160,409

The Examining Attorney contends that applicant's recited meats are identical to registrant's "meats"; that a number of applicant's other recited goods are used in making pizza, which may be served in registrant's restaurants; that food products and food services are closely related; and that it is common for restaurants to sell the food items served in the restaurants in grocery stores and other retail outlets. In support of her position, the Examining Attorney has submitted excerpts of articles from the LEXIS/NEXIS database.

Applicant argues that there is no likelihood of confusion because registrant operates a chain of pizza restaurants in Kentucky and Ohio and there is no indication

"that registrant engages in conventional retail sales of meats or any other retail products."⁷

Applicant's identified goods, various specified meats, are identical to the goods identified in Registration No. 1,452,339, meats. In view of the fact that applicant's mark is substantially identical to registrant's mark and their goods are identical, we find that a likelihood of confusion exists as to the source or sponsorship of such goods.

We also find that a likelihood of confusion exists as to the source or sponsorship of applicant's identified goods and registrant's restaurant services. The record supports, and applicant does not dispute, that restaurants offer for sale, both on and off their premises, private label food products. In fact, Registration No. 1,452,339

⁷ We find applicant's statement unsupported in this record and not relevant to the issue before us. The report submitted in support of this statement by applicant with its brief is untimely and, thus, will be given no consideration. Applicant did not comply with the established rule that the evidentiary record in an application must be complete prior to the filing of the notice of appeal. See, 37 CFR 2.142(d); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994). Further, even if the report had properly been made of record, applicant's contentions in this regard are unavailing as the registrations are geographically unrestricted and the identifications are broadly worded, containing no limitations as to the type of restaurant services. "The question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and/or services recited in [the] registration, rather than what the evidence shows the goods and/or services to be." Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987).

includes both meats and restaurant services, indicating that registrant itself both sells food products and offers restaurant services. Certain of applicant's identified goods, for example, pizza sauce, processed peppers and pasta, are products that could be packaged for sale as finished products by a restaurant and made available to consumers either at the restaurant or in supermarkets and specialty food stores. Further, if we reasonably conclude from the design element in one of registrant's marks that registrant's restaurant services include the sale of pizza, we note that at least some of the food products recited in the application are used to make pizza or as toppings for pizza. All of these factors lead us to conclude that applicant's goods are related to registrant's restaurant services.

Therefore, we conclude that in view of the substantial similarity in the commercial impressions of applicant's mark, GIOVANNI, and registrant's marks, GIOVANNI'S in Registration No. 1,452,339, and GIOVANNI'S and design in Registration No. 1,160,409, their contemporaneous use on the related goods and services involved in this case is likely to cause confusion as to the source or sponsorship of such goods and services.

Serial No. 75/045,478

Decision: The refusal under Section 2(d) of the Act is affirmed with regard to Registration Nos. 1,194,807, 1,452,339 and 1,160,409; and reversed with regard to Registration No. 1,940,288.

E. J. Seeherman

C. E. Walters

H. R. Wendel
Administrative Trademark Judges,
Trademark Trial and Appeal Board